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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/028,722

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Lester Benjamin Johnson

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03/27/2008

BAKER & HOSTETLER LLP  
WASHINGTON SQUARE, SUITE 1100  
1050 CONNECTICUT AVE. N.W.  
WASHINGTON, DC 20036-5304

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/028,722	<b>Applicant(s)</b> JOHNSON ET AL.	
	<b>Examiner</b> Dennis Ruhl	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Applicant's response of 1/4/08 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6,23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 6,23, it has not been claimed in claim 6 that there is any diagnostic equipment that is "linked" to the means for receiving. What does this limitation mean in claim 23 and what does it refer to from claim 6? It is not clear if the scope of claim 6 is supposed to include a recitation that requires that they are linked. This is not clear. If they are "linked" in claim 6, then that must mean that the diagnostic equipment is part of the scope of claim 6, so how can the system as claimed in claim 23 recite that the system further includes the diagnostic equipment? In what claim is the diagnostic equipment first recited as being in the scope of the claim?

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,5,6,10,11,15-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (20020072808) in view of Kirkevold et al. (6263322).

The applicant should take notice that in the system claims, the mechanic is not present in the claim scope. The mechanic is referred to in a functional sense as far as the intended user of the various claimed elements. For the system claims, the person that is intended to be the one that enters the data is not part of the claim scope so reciting that it is a mechanic that is to enter information and that it is the mechanic that is the one that is supposed to operate the diagnostic equipment is not further defining any structure to the system as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A mechanic is fully capable of operating the claimed elements, so the prior art satisfies what is claimed as will be explained below. Additionally, the prior art satisfies what is claimed with respect to the operation of the diagnostic equipment as will be explained.

For claims 1,6,11,20,21,23-26,28,29, Li discloses a system and method for providing vehicle information. Li discloses a system where a user (vehicle owner or automotive repair shop service associate, any user) can enter information concerning a given vehicle and the system can then analyze that information to give a diagnosis of what may be wrong with the vehicle. A service solution is determined as claimed. The system also can determine the warranty status of the vehicle based on the diagnosis of the problem (is problem covered under warranty, yes or no, see figure 11 of Li). See

figure 17 and paragraph 61 where it is disclosed that vehicle identification information is entered. The “means for entering the vehicle identification information” is satisfied by the computer interface 80 that allows entry of the claimed type of data. Figure 17 shows the VIN number being entered, which identifies the vehicle. The vehicle problem information entered into the system by the user is the claimed diagnostic information, which is analyzed to arrive at a service solution. See paragraph 42 for a disclosure of comparing the received diagnostic information to a symptoms database 90 to determine a prognosis. The “means for comparing” the received diagnostic information with reference information is module 30, that compares received vehicle diagnostic information to a symptoms database to determine a prognosis. This module 30 also satisfied the claimed “means for identifying at least one service solution. The results are then displayed as claimed, which also satisfies the claimed “means for displaying”, which is just a display. Databases are used to store the data (for claim 11). Also, see paragraph 45 where it is disclosed that there is a warranty module 41 that identifies warranty solutions, this satisfies the claimed “*means for identifying if the at least one service solution is covered under warranty*”.

Not disclosed by Li is that the diagnostic information is received “*directly from diagnostic equipment*”. In Li the data is entered manually and applicant is claiming a situation that is representative of an automated collection of vehicle diagnostic data. Also not disclosed for only claim 1 is that the vehicle identification information is entered by a mechanic.

Kirkevold discloses an auto repair shop computer system that manages just about every aspect of a repair shop that one can think of. It is specifically disclosed that the computer system includes diagnostic equipment (see figure 1, #1,12,14,16) that analyzes data taken from vehicles to diagnose a problem. For example see column 9, line 56 to column 10, line 18. The operator of the diagnostic equipment satisfies the claimed limitation of a mechanic, which is really just a title and is only defining a person. Clearly in the reference it is a repair technician (mechanic) that is operating the diagnostic equipment and repairing the vehicles. Kirkevold is disclosing the fact that is it well known in the auto repair art to take vehicle data directly from vehicle analyzer components 52, that are connected to a vehicle by the repair technician (which is a mechanic and satisfies what is claimed). In Kirkevold, the diagnostic data that is used to diagnose the vehicle problem comes directly from diagnostic equipment that is connected to the vehicles (see figure 1). Also, the examiner notes that Kirkevold recognizes that Diagnostic Trouble Codes can be retrieved from the on board computer of a vehicle, see column 11, lines 49-51. The on board computer satisfies an onboard monitoring system as is claimed in claim 21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Li so that data concerning vehicle problems can be received directly from the diagnostic equipment that is operated by a repair technician (mechanic), as is taught by Kirkevold. This is very well known to one of ordinary skill in the art. The receipt of data directly from diagnostic equipment would be desirable because it allows for more complex troubleshooting to occur, such as the obtaining of data by the various devices disclosed

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by Kirkevold (engine analyzer, alignment analyzer, brakes analyzer, etc.) that allow for more complex problem analysis than the system of Li can provide with just user objective input. A repair technician (mechanic) would use diagnostic equipment connected to the vehicle, like the disclosed engine analyzer of Kirkevold. The repair technician (mechanic) could also connect to the vehicle's on board computer to obtain error codes (as is disclosed by Kirkevold ) and this would then allow problem diagnosis to occur based on the received data. One of ordinary skill in the art would have found it obvious to collect the diagnostic data directly from diagnostic equipment that is operated by a mechanic.

With respect to the claimed entering of the vehicle identification information by a mechanic, Li discloses that a person enters this same information. It may be a customer or it may be an automotive repair shop service associate. The entering of the vehicle information can be done by anyone, it does not matter who is doing it. Because the rejection results in the vehicle diagnostic information being taken from diagnostic information operated by a mechanic, it would make sense that somebody such as a mechanic at the repair shop would also enter the vehicle identification information. The examiner also notes that it does not appear to matter who it is that enters the data. The method does not depend on a specific individual entering the information and the invention would perform the same if a person other than a mechanic entered the vehicle identification information. The specification does not disclose that having a mechanic enter the vehicle identification information solves any particular problem or that this produces any unexpected result. It also makes sense that if an automotive repair shop

service associate is able to enter the information that it would have been obvious to try and have a mechanic also enter the information (maybe the service associate is out sick that day). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the mechanic enter the vehicle identification information for the above reasons.

For claims 5,10,15, not disclosed is that the entered vehicle identification information is the make, model, and year of the car. In Li, it is disclosed that the VIN (vehicle identification number) is entered. The VIN number represents the make, model, year, and options that the vehicle has. One of ordinary skill in the art would readily appreciate this fact and would have found it obvious to have the vehicle identification information that is entered be the make, model, and year, as claimed. Li discloses the entering of vehicle ID data and modifying Li to accept the make, model, and year, as opposed to the VIN number, is something that one of ordinary skill in the art would have found obvious.

For claims 22,27, Kirkevold discloses the use of hand held diagnostic equipment, such as equipment 5 and 6 as shown in figure 1. the 103 combination also includes these features as being provided to Li. The 103 combination is providing Li with the ability to collect data from the various devices disclosed by Kirkevold.

For claims 16,17, not disclosed is that Li is configured to receive information (diagnostic and vehicle identification information) wirelessly. Li discloses in paragraph 40 that various communication networks can be used, "or other networking technologies" (i.e. LANs, WANs, global networks). Wireless transmission of information



is something that is old and well known in the art. One of ordinary skill in the art would certainly be aware of the fact that there are wireless networks in existence where data can be transferred wirelessly. This is something that one of ordinary skill in the art would be aware of as of the effective filing date for this application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Li with wireless data communication ability, so that the data could be transferred by wireless communication, as is well known in the art.

For claims 18,19, not disclosed is that the data input is configured to use the TCP/IP protocol. The TCP/IP protocol is something that is well known to one of ordinary skill in the art. This type of data transfer protocol was developed many years ago and is something that one of ordinary skill in the art would be very aware of. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the data input of Li with the TCP/IP protocol. In view of the fact that in Li a user can interact with the system from home via computer, one of ordinary skill in the art would recognize that the TCP/IP protocol would be desirable, especially because this kind of protocol is used extensively for the Internet.

5. Applicant's arguments filed 1/4/08 have been fully considered but they are not persuasive.

With respect to the 112,2<sup>nd</sup> rejection for claim 23, see the new reasoning of why this claim is indefinite in the current rejection of record. This was in response to the most recent amendment. The claim is still considered to be indefinite.

With respect to the traversal of the 103 rejection of Li in view of Kirkevold, it is not persuasive. Applicant seems to allege that the limitation that recites that the parts of the invention are intended for use by a mechanic distinguishes over the prior art. The applicant never explained why this limitation is believed to define over the prior art. The argument is taken as just an allegation of patentability because no reasoning has been provided to the examiner to consider. The examiner disagrees and refers applicant to the rejection of record that addresses this newly added limitation. This was the only argument presented for patentability. The rejection will be maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/

Primary Examiner, Art Unit 3689